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10/074,028

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Bernadette Mary Gibbs

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08/22/2005

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EXAMINER

KIDWELL, MICHELE M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/074,028 | Applicant(s) GIBBS, BERNADETTE MARY | |
| | Examiner Michele Kidwell | Art Unit 3761 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,17-25 and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-16 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims 3 – 4, 17 – 25 and 34 – 37 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the term “fully-extended” is not supported by the originally filed specification.

The amendment filed June 8, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the claims have been amended to recite side portions in a fully-extended condition. This configuration is not supported by the originally filed disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 2, 5 – 10, 13, 26, 28 and 32 – 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Suekane (US 5,628,738).

With reference to claim 1, Suekane discloses an absorbent article comprising a main body having a first main body waist portion, a second main body waist portion and a central main body portion disposed between the first and second main body waist portions, the main body having orthogonal longitudinal and lateral axes; and a pair of elastic side panels each connecting the first main body waist portion to the second main body waist portion, the main body and the side panels collectively defining a waist opening edge surrounding a waist opening and two leg opening edges, each leg opening edge surrounding a leg opening, each elastic side panel having a first side portion extending laterally outward from the first main body waist portion and terminating in a first outer lateral side panel edge, and a second side portion extending laterally outward from the second main body waist portion and terminating in a second outer lateral side panel edge, the first side portion being attached to the second side portion by a side seam, at least a portion of the side seam being curved when the first and second side portions are in a fully extended condition as set forth in figures 1 – 2.

The examiner contends that the claimed limitation requiring that at least a portion of the side seam is curved when the first and second side portions are in a fully extended condition is a recitation of the intended use of the claimed invention. This recitation must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The article of Suekane is fully capable of performing the recited function.

Further, the examiner contends that if a user fully extends the sides of Suekane by pulling the areas outward by reference character 15 on both sides of the garment, the article of Suekane would also meet the claimed limitations.

As to claim 2, Suekane discloses an absorbent article wherein the absorbent article comprises a backsheet (3) and wherein the main body includes a first portion of the backsheet, a topsheet (2) attached to the first portion of the backsheet and an absorbent core (4) disposed intermediate the topsheet and the first portion of the backsheet, the elastic side panels being formed at least in part from a second portion of the backsheet as set forth in col. 3, lines 6 – 16 and figures 1 – 2.

As to claims 5 – 10, 13 and 26, Suekane discloses an absorbent article meeting the claimed limitations as set forth in the rejection of claim 1 and in figure 2.

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With reference to claim 28, see the rejection of claim 1.

With respect to claims 32 and 33, the examiner contends that the claimed limitations are a recitation of the intended use of the claimed invention. This recitation must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The article of Suekane is fully capable of performing the recited functions.

Further, the examiner contends that if a user fully extends the sides of Suekane by pulling the areas outward by reference character 15 on both sides of the garment, the article of Suekane would also meet the claimed limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 – 12, 14 – 16, 27, 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suekane (US 5,628,738).

The difference between Suekane and claim 11 is the provision that the first seam angle is in a range from about 10 to about 50 degrees.

It would have been obvious to one of ordinary skill in the art to modify the first seam angle in order to compose the most effective product since it has been held that where the general conditions in a claim are disclosed in the prior art, discovering the optimum or workable range involves only a level of ordinary skill in the art.

With respect to claims 12, 14 – 16, 29 – 31, see the rejection of claim 11.

With reference to claim 27, absent a critical teaching and/or unexpected result, the examiner contends that the claimed limitation is an obvious matter of design choice that does not patentably distinguish the claimed invention from the prior art.]

Response to Arguments

Applicant's arguments filed June 8, 2005 have been fully considered but they are not persuasive.

With respect to the applicant's argument that Suekane does not disclose a side seam that is at least partially curved, the examiner disagrees. The claims recite at least a portion of the side seam being curved when (emphasis added) the first and second side portions are in a fully extended condition.

Initially, the examiner notes the objection to the language "fully-extended" which is considered new matter and is not supported by the originally filed disclosure. Nonetheless, the examiner contends this language a recitation of the intended use of the claimed invention. This recitation must result in a structural difference between the

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claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The article of Suekane is fully capable of performing the recited function.

Further, the examiner contends that if a user fully extends the sides of Suekane by pulling the areas outward by reference character 15 on both sides of the garment, the article of Suekane would also meet the claimed limitations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday - Friday, 5:30am - 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michele Kidwell
Primary Examiner
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